Remarks

Claims 1 and 3-15 are pending in the application. The Examiner has rejected Claims 1 and 3-15. Claim 1 has been amended. No new matter has been introduced.

Claim Rejections under 35 U.S.C 112

The Examiner has rejected claims 1 and 3-15 under 35 U.S.C. 112 1st paragraph as failing to comply with the written description requirement. The Examiner asserts that the claim limitation of the elongated conduit not penetrating the tissue lacks support in the Applicant's specification. While Applicant believes this feature of the claim has implicitly and inherently been disclosed throughout the specification, the Applicant elects not to respond to this rejection at this time, but instead to remove the limitation by amendment to expedite the prosecution of the application.

Claim Rejections under 35 U.S.C 102

The Examiner has rejected Claims 1, 3-6 and 9-11 under 35 U.S.C. 102(e) as being anticipated by Jenkins et al. (US 6,645,199). Reconsideration and allowance are respectfully requested.

Claim 1 now recites an implantable surgical drain to be placed against a tissue of a patient's body for draining fluid and sensing at least one physiological property of the tissue comprising: an elongated conduit configured to be implanted in a patient's body and to rest against ~~but not penetrate~~ the tissue of

the body, and to drain wound fluid from the body, the elongated conduit including a first and a second surface on an outer side of the elongated conduit; at least one sensing element positioned on the first surface of the elongated conduit configured to sense a physiological property of the tissue; and an inflatable compartment positioned behind the sensing element, configured to push the sensing element against the tissue so as to enhance contact between the sensing element and the tissue.

The elongated conduit of claim 1 as now amended includes the limitation of the conduit draining wound fluid. Support for this feature is found in paragraphs 51 and 114 of the Applicant's specification.

To the contrary, Jenkins does not teach draining wound fluid. In fact, Jenkins does not have the capability of removing any body fluid from the body. In fact, if the Examiner's interpretation of Jenkins were correct, then the device's capability to drain fluid from the pulmonary vein would result in draining of the patient's blood, which could actually endanger the patient's life.

In addition, Jenkins et al.'s probe 12 (which includes the loop structure 14 housing the temperature sensors 196) is oriented relative to the separate probe 16 (which includes the expandable push structure 18 or inflatable push structure 118) so as to actively position the loop structure 14 (with the temperature sensors 196) on the distal side of the separate inflatable push structure 118 (See Figs. 2 and 12A). Applicant agrees that the expansion of the inflatable push structure 118 will push the loop structure 14 against the tissue (column 6, lines 25-26 and lines 29-32, column 13, lines 58-61). However, the inflatable push

structure 118 shown in Fig. 10A does not push the mapping basket 11 holding the electrodes 104 (not sensing elements) against the tissue as claimed by the Examiner (see page 2 of the office action). The Jenkins et al.'s device would not function properly if the expandable/inflatable push structure 18/118 was fixed under the loop structure 14 housing the temperature sensors 196.

Therefore, Jenkins et al. fail to anticipate independent claim 1. Claims 3-15 are dependent on claim 1 and are similarly not anticipated by Jenkins et al.

Claim Rejections under 35 U.S.C 103

The Examiner has rejected Claim 7 under 35 U.S.C 103(a) over Jenkins et al. in view of Fiddian-Green (US 6,334,064). The Applicant respectfully requests reconsideration and allowance.

Fiddian-Green does not remedy Jenkins et al.'s failure to teach the limitations of claim 7. Specifically, Fiddian-Green fails to teach the elongated conduit of claim 1 that is configured to rest against the tissue and further drain wound fluid from the tissue. Fiddian-Green's catheter would only be able to operate within the tissue. Therefore, Fiddian-Green fails to remedy the deficiencies of Jenkins et al., and Claim 7 is not obvious in view of the cited prior art.

The Examiner has rejected claim 8 as being obvious in view of Jenkins et al. Jenkins fails to teach the newly added feature (draining wound fluid) of the claim. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (M.P.E.P 2143.03).The

Examiner further asserts that prior art to Wittes et al. (US 3,680,562), Torre et al. (US Patent Publication 2002/0055757) and Schoolman (US 5,215,539) variously teach the additional limitations of dependent claims 12-15. However, none of the cited prior art remedies the deficiencies of Jenkins et al. as discussed above with respect to claim 1.

Therefore, claims 12-15 are not obvious and should be allowed.

CONCLUSION

Applicant respectfully submits that the above amendment and remarks place this application in a condition for allowance, which the Applicant respectfully solicits.

Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account 501946 and please credit any excess fees to such deposit account and reference attorney docket no. 64693-0103.

Respectfully submitted,
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